REMARKS/ARGUMENTS

Claims 2-10, 12-16 and 18-28 are pending in the application. In the Office Action mailed July 26, 2007, the Examiner withdrew the restriction requirement, and withdrew his rejection of claims 2-10, 12-16 and 18-28 under 35 U.S.C. 103 (a) as being unpatentable over Miracle et al. '282 and Perkins '968 in further combination with McAllise et al. '977 in view of a Notice of Panel Decision from Pre-Appeal Brief Conference mailed October 23, 2006. Applicants appreciate the withdrawal of the restriction requirement and the prior rejection of the claims. The Examiner has now rejected all of the claims over essentially the same or similar references and has merely recast the same arguments in somewhat different format. However, the substance of the Examiner's rejections has not changed and is flawed for the same reasons as the prior rejections. The Examiner continues to mischaracterize the McAllise et al. '977 reference and continues to ignore the decision of the Board of Patent Appeals and Interferences (BPAI) without justification.

The rejections of the claims are not proper and are without basis in fact or law. The Examiner's rejections continue to be based on a clear legal and/or factual deficiency and not based on interpretation of claims or prior art teachings. In particular, the rejection of claim 21 and dependent claims 2-10, 12-16, 19, 20 and 22-28 is contrary to the decision of the Board of Patent Appeals and Interferences (BPAI) in this matter and is not supported in fact by the record. Further, the Examiner has not made a *prima facie* case of unpatentability of claim 18 under 35 U.S.C. § 103 as required by *In re Vaeck* 947 F.2d 488, 20 USPQ 2nd 1438 (Fed. Cir. 1991).

The Examiner has not made a prima facia case of unpatentability of claim 18.

Claim 18 has been rejected under 35 U.S.C. 103 (a) as being unpatentable over the US patent to McAllise et al. 5.500,977 (McAllise et al. '977) in view of the Miracle et al. US patent 5, 576, 282 (Miracle et al. '282). This rejection is respectfully traversed.

The BPAI, in reversing the Examiner's rejection of claim 18, in a footnote stated "the Examiner and the Appellants should consider and resolve whether the claims under consideration patentably distinguished over the combined teachings of Miracle and McAllise et al. patent (e.g. see Figures 8b and 11a, the paragraph bridging columns 8 and 9 as well as lines 11-26 in column 12)." (BPAI Opinion at page 7). Applicants believe that the substance of the

BAPI decision is that the Miracle et al. '282 reference could reasonably be combined with a carpet extractor although the BAPI did not consider the combination of McAllise et al. '977 and Miracle et al. '282. Therefore, the combined teaching of McAllise et al. '977 and Miracle et al. '282 is that the Miracle et al. '282 composition could be added to the solution tank of McAllise et al. '977. However, this combination does not reach the invention claimed in claim 18.

The teaching of McAllise et al. '977 is set forth on Pages 2 and 3 of Applicants Response to Office Action filed on April 4, 2006, which is incorporated herein by reference.

There is no disclosure in McAllise et al. '977 as to the source of the "warm, moist exhaust air from motor fan 610" to which the Board and Examiner refer. The Examiner contends "McAllise et al. specifically teaches and discloses that the air is warmed by motor 610 prior to admixing with the cleaning solution at the discharge nozzle (Column 12, lines 11-26)." This allegation is not supported in fact in the McAllise et al. '977 reference and is patently false. There is nothing in the cited passage in McAllise et al. '977 that supports the Examiner's conclusion. The passage merely states that the motor *fan* 610, not the motor, discharges the air to nozzle 55. The cited passage discloses that air from the recovery tank 50 is drawn through the inlet plenum 619 of the motor fan via standpipe 612 and 572. This passage is clearly shown in Figures 2, 5, and 6 of McAllise et al. '977. This air passage completely avoids the motor 626 (see Figure 2). See also Column 3, lines 33-39, and Figures 2, 6, and 8b which disclose a separate cooling path for the motor 626, which is common in extractors. Therefore, it is quite clear from a reading of MacAllise et al. '977, that the Examiner's representation of heating of the exhaust air by motor 28 is without foundation in the McAllise et al. ' 977 reference and contrary to fact.

Thus, the Examiner's alleged combination of McAllise et al. '977 and Miracle et al. '282 does not teach either of the following two steps:

- Mixing the admixture with heated air to heat the admixture; and
- Heating the air before the step of mixing the admixture with heated air.

Contrary to the Examiner's unfounded statements with respect to the disclosure in the McAllise et al. '977 patent, neither McAllise et al. '977, nor the alleged combination of the McAllise et al. '977 and Miracle et al. '282 disclose these claim limitations.

The rejection of claim 21 and the claims dependent therefrom is contrary to the decision of the BPAI.

Claim 21 as amended following the decision by the BAPI reads as follows:

> 21. (Currently amended) A method for cleaning an upholstery or carpet surface in which a fluid carpet or upholstery cleaning solution is dispensed onto the upholstery or carpet surface to be cleaned and the cleaning solution is recovered from the surface with suction, comprising the steps of:
>
> admixing an oxidizing agent with the cleaning solution prior to the step of dispensing the cleaning solution onto the upholstery or carpet surface; and
>
> ~~according to claim 1 and further comprising the step of~~ heating the cleaning solution before the admixing step to heat the admixture.

See Amendment under 37 CFR § 1.197 filed October 13, 2005.

Claim 21 and the claims dependent therefrom have been rejected as unpatentable over the U.S. patent to Wang 5,987,696 (Wang '696) in view of Miracle et al. '282. This rejection is respectfully traversed.

The Wang '696 patent discloses a carpet cleaning machine in which a reservoir 320 is connected to an application subsystem 400 (wand) through a fluid pump 310 and a heater 340. Wang '696 discloses nothing more with respect to the subject matter of claim 21 than the Perkins '986 reference cited in the previous Office Action or the Ligman '595 patent or Sham '612 patent that the Examiner cited in his final rejection that was reversed by the BAPI. Thus, the Examiner's combination of Wang '696 and Miracle et al. '282 is no different than the Examiner's flawed combination of Perkins '968 and Miracle et al. '282, which was reversed by the Panel Decision from Pre-Appeal Brief Conference, and further is no different than the Examiner's combination of Ligman '595 or Sham '612 and Miracle et al. '282, which was reversed by the BAPI. The Examiner continues to ignore the BAPI decision which is the law of the case. Merely recasting the same old rejection is different cloth does not change the nature of the flawed reasoning. The Examiner is respectfully requested to follow the Rules of the Patent Office and the law of the case and cease this protracted prosecution of this application.

For the Examiner's edification, claim 21 was the subject of the Appeal to the Board of Patent Appeals and Interferences. It depended from claim 1 and added the limitation of "heating

the cleaning solution before the admixing step to heat the admixture" as shown above. The Examiner had rejected these claims over Miracle et al.'282 in view of the Ligman U.S. Patent No. 5,555,595 (Ligman '595 patent) or Sham U.S. Patent No. 5,386,612 (Sham '612 patent). In its decision of August 17, 2005, the BPAI held that the Miracle et al. '282 patent was properly combined with Sham '612 or with Ligman '595 as a prior art teaching of incorporating the Miracle oxidizing composition in either the Sham '612 or the Ligman '595 solution tanks to meet the limitations of claim 1. BPAI Opinion, p 3-5. Applicants do not dispute this holding of the BPAI.

The Wang '696 reference discloses nothing more than what is disclosed in the Sham '612 or the Ligman '595 references with respect to the claimed invention of claim 21. The Examiner has not articulated any differences between the Wang '696 reference and either of the Sham '612 or the Ligman '595 references. Therefore, Applicants believe that the decision of the BPAI with respect to the claims in this application controls and is the law of the case.

Turning now to the decision of the BPAI as it relates to amended claim 21, the BPAI's decision reads in relevant part as follows:

> Similarly, the references applied by the Examiner contain no teaching or suggestion of "the step of heating the cleaning solution before the admixing step the admixture" as recited in separately grouped claims 11, 17 and 21. Apparently in reference to these claims, the Examiner states "The order of mixing will not be given patentable weight in the absence of showing superior or unexpected results" (Answer, page 13). This wholly inappropriate statement is directly contrary to long-established precedents. *See, for example, In re Wilson*, 424F2nd 1382, 1385, 1 65USPQ 494, 496 (C.C.P.A 1970) (All words in a claim must be considered in judging the patentability of that claim against the prior art.) Under these circumstances, we again are compelled to hereby reverse the Examiner's § 103 rejection vis-à-vis claims 11, 17, and 21 as being unpatentable over Miracle in view of Ligman or Sham. (BPAI, page 7-8).

The Examiner's alleged combination of Wang '696 and Miracle et al. '282 contains no teaching or suggestion of claimed step of "heating the cleaning solution before the admixing step to heat the admixture" which is the very same limitation that the BPAI found was not in the prior art references. The Examiner has not demonstrated any disclosure in this combined teaching of the step of heating a cleaning solution before admixing the cleaning solution with an oxidizing

agent as required by claim 21. The Examiner points to some disclosure in Miracle et al. '282 as to the enhanced effectiveness of the oxygen bleaching solutions at higher temperatures but this disclosure has nothing to do with the step of heating the cleaning solution prior to mixing the cleaning solution with the oxidizing agent. This teaching of Miracle et al. '282 is consistent with mixing the Miracle et al. '282 composition with the cleaning solution in the Wang '696 reservoir 320. No other interpretation of the alleged combination of Wang '696 and Miracle et al. '282 is possible. The Examiner's flawed logic does not support the step of heating the cleaning solution prior to mixing the cleaning solution with the oxidizing agent. Besides, this teaching of Miracle et al. '282 was before the BAPI who rejected the combination of Miracle with references no different in substance than the Wang '696 reference. Thus, the rejection of a claim 21 and the claims dependent therefrom under 35 U.S.C. § 103(a) over Wang '696 in view of Miracle et al. '282 is unsupported and is inconsistent with the BPAI decision in this matter.

Claims 2-10, 12-16 and 17-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over McAllise et al. '977 in view of Miracle et al. '282. This rejection is respectfully traversed. Both of the McAllise et al. '977 and Miracle '282 have been discussed above.

This rejection, like the rejection of the same claims under 35 U.S.C. § 103(a) as being unpatentable over Wang et al. '696 and Miracle '282 are fatally flawed because they are contrary to the decision of the BAPI for all the same reasons set forth above. The McAllise et al. '977 patent discloses nothing more than what is disclosed by Wang et al. '696, Perkins '986, Ligman '595 and Sham 612' with respect to these claims. The Examiner's alleged combination of McAllise et al. '977 and Miracle '282 discloses nothing more than what was before the Board of Appeals in the Examiner's combination of Ligman '595 or Sham '612 and Miracle et al. '282 which was reversed by the BAPI. The alleged teaching of McAllise et al. '977 and Miracle '282 discloses nothing more than adding the Miracle bleaching composition to the solution tank of McAllise et al. '977. The BAPI held that this combination of references "contained no teaching or suggestion of the step of heating the cleaning solution before the admixing step" as recited in separately grouped claims 11, 17 and 21. The Examiner is invited to review the BAPI decision.

The Examiner's alleged combination of McAllise et al. '977 and Miracle '282 contains no teaching or suggestion of the claims step of "heating the cleaning solution before the admixing step to heat the admixture" which is the very same limitation that the BPAI found was not in the prior art references. The Examiner has not demonstrated any disclosure in this combined teaching of the step of heating the cleaning solution before admixing the cleaning solution with an oxidizing agent as required by claim 21. The Examiner repeats the very same passages from Miracle that he made in the above rejection of claim 21 as support for his allegation that the missing heating-before-admixing step is taught by the alleged combination of McAllise et al. '977 and Miracle '282. However, as pointed out above, the disclosure in Miracle as to the enhanced effectiveness of oxygen bleaching solutions at higher temperatures has nothing to do with the step of heating the cleaning solution prior to mixing the cleaning solution with the oxidizing agent. The Miracle et al. '282 disclosure is consistent with mixing the Miracle et al. '282 composition with the cleaning solution in the McAllise et al. '977 solution tank. No other interpretation of the alleged combination of these references is possible. The Examiner's flawed logic does not support the step of heating the cleaning solution prior to admixing the cleaning solution with the oxidizing agent as required by claim 21 and the claims dependent therefrom. In addition, this teaching of Miracle et al. '282 was before the BAPI who rejected the combination of Miracle with references no different in substance than the McAllise et al. '977 reference. The rejection of claims 2-10, 12-16, and 17-28 under 35 U.S.C. § 103(a) as unpatentable over McAllise et al. '977 in view of Miracle et al. '282 is unsupported and inconsistent with the BPAI decision in this matter.

CONCLUSION

In view of the foregoing remarks, it is submitted that all of the claims are in condition for allowance. Early notification of allowability is respectfully requested.

Respectfully submitted,

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